

Application No. 09/941,839  
Art Unit 1731  
October 10, 2003  
Reply to Notice of Non-Compliant Amendment  
dated October 3, 2003

**REMARKS**

On October 3, 2003, a Notice of Non-Compliant Amendment issued in the matter of the above-identified application.

The Notice indicated that the Amendment filed on September 8, 2003, is considered non-compliant because it has failed to meet the requirements of 37 C.F.R. § 1.121, as amended on June 30, 2003. Specifically, claim 1 did not have the proper status identifier.

Accordingly, attached hereto is a corrected version of the Amendment originally filed on September 8, 2003. Claim 1 now is correctly identified as "Currently Amended". A copy of the Terminal Disclaimer originally filed on September 8, 2003, is also attached (newly executed). No fees are required, since the fee for the Terminal Disclaimer was paid on September 8, 2003.

**Conclusion**

A full and complete response has been made to the Office Action, and Applicant has taken substantial steps in an effort to advance prosecution. Applicant respectfully requests that a timely Notice of Allowance be issued in the present application.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the

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undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Gerald M. Murphy, Jr., #28,977

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**AMENDMENTS TO THE CLAIMS**

This listing of claims will replace all prior versions, and listings, of claims in the present application.

***Listing of Claims:***

1. (Currently Amended) A cellulose acetate structure, at least a surface region of which comprises a biodegradable cellulose acetate composition comprising a biodegradation promoting agent contained in cellulose acetate and comprising at least one compound selected from the group consisting of an ~~ester of an oxygen acid of phosphorus, a salt of an ester of an oxygen acid of phosphorous, carbonic acid and a salt of carbonic acid.~~ cellulose phosphate and starch phosphate.

2. (Original) The cellulose acetate structure according to claim 1, wherein said cellulose acetate has a DS value falling within a range of between 2.0 and 2.6.

3. (Canceled)

4. (Canceled)

5. (Original) The cellulose acetate structure according to claim 1, wherein said biodegradation promoting agent is contained in an amount of 0.01 to 10% by weight based on said cellulose acetate.

6. (Original) The cellulose acetate structure according to claim 1, wherein said biodegradation promoting agent is in the form of fine particles, and said biodegradable cellulose acetate composition further contains a dispersant for dispersing said fine particles in said composition.

7. (Previously Presented) The cellulose acetate structure according to claim 1, further comprising a photodegradation promoting agent.

8. (Original) The cellulose acetate structure according to claim 7, wherein said photodegradation promoting agent comprises titanium oxide.

9. (Original) The cellulose acetate structure according to claim 1, wherein said cellulose acetate structure is in the form of fibers.

10. (Previously Presented) The cellulose acetate structure according to claim 1, wherein said cellulose acetate structure is in the form of an unwoven fabric formed of short fibers having a length of 1 to 100 mm.

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11. (Original) A tobacco filter comprising the cellulose acetate structure defined in claim 9.

12. (Original) A tobacco filter comprising the cellulose acetate structure defined in claim 10.

**REMARKS**

Claims 1-2 and 5-12 are pending in the present application. Claim 1 has been amended, and claims 3-4 have been canceled. No new matter has been added by way of the amendment to claim 1, because the amendment is made to merely incorporate the subject matter of canceled claim 4. Further, the present specification at page 9, lines 12-14 supports this amendment.

Based upon the above considerations, entry of the present amendment is respectfully requested.

Applicant's previous remarks of April 7, 2003, have been rendered moot in view of the new ground(s) of rejection. In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

**Issues of Obviousness-type Double Patenting**

Claims 1 and 3-5 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,571,802 (hereinafter referred to as "the '802 patent"). Further, claims 2 and 7-12 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of the '802 patent in view of Tsugaya et al. (U.S. Patent No. 5,711,322; hereinafter "Tsugaya '322"). In addition, claim 6 stands rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of the '802 patent in view of Barkowsky et al. (U.S. Patent No. 5,744,523; hereinafter "Barkowsky '523"). Applicant respectfully traverses.

A Terminal Disclaimer is being filed concurrently with this Amendment, rendering moot all of these obviousness-type double patenting rejections. Thus, Applicant respectfully requests the Examiner to withdraw all of these rejections.

**Issues Under 35 U.S.C. § 103(a)**

Claims 1-3, 5 and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsugaya '322. Also, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsugaya '322 in view of Barkowsky '523. Applicant respectfully traverses.

Applicant respectfully submits that the instantly pending claims are patentably distinct over the cited references. However, the stated rejections are rendered moot.

Claim 4 of this application is free of prior art. Claim 1 incorporates the subject matter of claim 4 (now canceled). Claims 2 and 5-12 ultimately depend on claim 1. Thus, Applicant respectfully submits that all presently pending claims are in condition for allowance. Accordingly, reconsideration and withdrawal of these rejections is respectfully requested.

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**Conclusion**

A full and complete response has been made to the Office Action, and Applicant has taken substantial steps in an effort to advance prosecution. Applicant respectfully requests that a timely Notice of Allowance be issued in the present application.

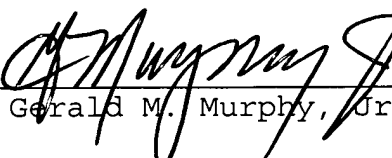
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Terminal Disclaimer